REMARKS

I. General

Claims 1, 4, 10, and 17-28 are pending in the present application. Claims 1, 4, 10, 17, and 26-28 have been withdrawn from consideration as being drawn to a non-elected invention. Claims 18 and 25 stand rejected under 35 U.S.C. § 102(b). Claims 18-24 stand rejected under 35 U.S.C. § 103(a). Applicants respectfully traverse the outstanding rejections and requests reconsideration and withdrawal in light of the remarks contained herein.

II. The 35 U.S.C. § 102 Rejections

Claims 18 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by February 1996 *Consumer Reports Magazine* (hereinafter *Consumer Reports*). Claim 18 further stands rejected under 35 U.S.C. § 102(b) as being anticipated by Bullard, Jr., patent number 4,968,061 (hereinafter *Bullard*). In order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, not only must every element of the claims be met, but "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicants respectfully assert that the applied references do not teach every element of the claims nor do they teach the identical invention in as complete detail as is contained in the claims.

For example, Applicants again point out that independent claim 18 and the claims dependent therefrom are directed to "[a] magazine for use in promoting the purchase of specific products . . . ." In addressing Applicants' previously stated arguments with respect to the claims being directed to a magazine for use in promoting the purchase of specific products, the Examiner asserts that *Consumer Reports*' "Best Buy" rating clearly promotes the purchase of the product rated as a "Best Buy" and, therefore, that *Consumer Reports* is for use in promoting the purchase of a specific product. However, this simply is not the case.

The express policy of "no advertising" is printed on the cover of *Consumer Reports*, as pointed out by Applicants in the Amendment filed June 14, 2001. Consistent with this policy underlying the publication, the publishers of *Consumer Reports*, Consumers Union, expressly forbids the use of *Consumer Reports* for promotion of any specific product. For example, Consumers Union has a no-commercialization policy which states that "[n]either the Ratings nor the reports nor any other information, nor the name of Consumer Union or

any of its publications, may be used in advertising or for any other commercial purpose," see Consumers Union No-Commercialization Policy at http://64.224.97228/aboutcu/about.htm (a copy of which is attached hereto for the Examiner's convenience). Consistent with this no-commercialization policy, Consumers Union states with respect to *Consumer Reports* that "Our mission since 1936: Test, Inform, Protect. We accept no ads," see *Consumer Reports* Online at http://www.consumerreports.org/main/homeljsp (a copy of which is attached hereto for the Examiner's convenience). Accordingly, Applicants respectfully assert that the *Consumer Reports* "Best Buy" rating does not meet the claim. Moreover, the "Best Buy" rating cannot properly be modified to promote the purchase of specific products, as recited in the present claims, without unpermissably ignoring the teachings of the reference, see M.P.E.P. § 2145X.D.2.

The Examiner further asserts that an advertisement for the "Complete Drug Reference" on page 29 of *Consumer Reports* is an article that promotes the purchase of a specific product. However, Applicants remind the Examiner that it is the words of the claim which must be considered in judging the patentability of the claim against the prior art, see M.P.E.P. § 2143.03. The above identified language of claim 18 recites "[a] magazine for use in promoting the purchase of specific products . . ." (emphasis added). It is immaterial as to whether the passage upon page 29 of *Consumer Reports* is an article that promotes the purchase of a specific product, because *Consumer Reports* does not teach or suggest a magazine that promotes the purchase of a specific product as shown above.

In addressing Applicants' previously stated arguments with respect to the claims being patentable over the disclosure of *Bullard*, the Examiner asserts that *Bullard* discloses that the advertising media includes magazines, books and newspapers, all of which are known to include general interest articles. However, Applicants' position is not simply that the claims recite a magazine including general interest articles, but that the claims recite a magazine comprising a plurality of general interest articles, with at least one of the general interest articles including within its confines specific brand information pertaining to an identified product. As previously pointed out by Applicants, *Bullard* does not teach or suggest general interest articles which include reference to an identified product with specific brand information pertaining to the identified product. Instead, *Bullard* merely teaches that "[t]he depth of each slot can extend down to the specific page containing a description or advertisement of the goods represented by the sample placed within that specific slot,"

column 2, lines 55-58. Even if it is accepted *arguendo* that the magazines, books, and newspapers disclosed in *Bullard* are known to include general interest articles, the disclosure of *Bullard* is insufficient to teach or suggest general interest articles referencing an identified product and including specific brand information pertaining to the identified product, as recited in the claims.

Applicants note the Examiner's admonition that "one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references." However, Applicants respectfully point out that the above distinctions were previously made with respect to 35 U.S.C. § 102 rejections and, therefore, properly redress the rejections of record to which they pertain.

Moreover, as it is required that any combination of prior art under 35 U.S.C. § 103 meet every element of the claims, it is proper to address applied references individually for the particular aspects of the claims relied upon by the Examiner as being taught or suggested thereby, see M.P.E.P. § 2143. Accordingly, to the extent that the examiner relies upon *Consumer Reports* or *Bullard* in any combination of art of record to teach or suggest the above identified aspects of the claims, it is respectfully asserted that a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established.

Although not conceding that the prior art of record is sufficient to anticipate claims 18 and 25, Applicants have amended independent claim 18 to recite the limitations previously submitted in dependent claim 24. Claim 18 now presents previously submitted claim 24 in independent form. Accordingly, claim 24 has been canceled by this Amendment. As both independent claim 18 and dependent claim 25 now recite limitations of a previously submitted claim not rejected under 35 U.S.C. § 102, Applicants respectfully assert that the 35 U.S.C. § 102(b) rejections of record with respect to claims 18 and 25 are now moot.

III. The 35 U.S.C. § 103 Rejections

Claims 18-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bullard* in view of Lamphere et al., patent number 5,127,674 (hereinafter *Lamphere*). Claims 18 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bullard* in view of Shedd, patent number 2,215,163 (hereinafter *Shedd*).

To establish a *prima facie* case of obviousness, three basic criteria must be met, see

M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the second criteria, Applicants respectfully assert that the references lack proper motivation to combine in addition to lacking all the claim limitations. Applicants respectfully assert that a magazine meeting the claims is not taught or suggested by the applied combinations of prior art.

In rejecting claim 18 over *Bullard* in view of *Lamphere*, the Examiner opines that *Bullard* shows a magazine with all the features of the Applicants' claimed invention except for the magazine being specific to a particular store. However, as shown above, *Bullard* does not teach or suggest general interest articles which include reference to an identified product with specific brand information pertaining to the identified product. Instead, *Bullard* merely teaches that "[t]he depth of each slot can extend down to the specific page containing a description or advertisement of the goods represented by the sample placed within that specific slot," column 2, lines 55-58. Even if it is accepted *arguendo* that the magazines, books, and newspapers disclosed in *Bullard* are known to include general interest articles, the disclosure of *Bullard* is insufficient to teach or suggest general interest articles referencing an identified product and including specific brand information pertaining to the identified product, as recited in the claims.

The disclosure of *Lamphere* does not cure the above identified deficiency in the disclosure of *Bullard*, and the Examiner has not asserted otherwise. Applicants' Attorney's review of *Lamphere* does not reveal any hint or suggestion of a magazine including an article as recited in the claims. Moreover, *Lamphere* does not appear to even teach a magazine for use in promoting the purchase of specific products. Instead, *Lamphere* teaches a "clutch purse type coupon-holding device," see column 7, lines 20-21.

Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 18. Therefore, it is respectfully asserted that claim 18 and the claims dependent therefrom are allowable under 35 U.S.C. § 103 over *Bullard* in view of *Lamphere*.

The 35 U.S.C. § 103 rejection of record with respect to claim 24, the limitations of which now appear in claim 18 as amended, relies upon a combination of *Bullard* in view of

Shedd. Specifically, the Examiner asserts that *Bullard* shows a magazine with all the features of the claimed invention except the coupons. The Examiner opines that "[i]t would have been obvious to one of ordinary skill in the art in view of the coupons 3 in the promotional book of *Shedd* to provide the magazine of *Bullard*, Jr. with coupons to encourage sales."

However, the language of the claim requires that "said magazine compris[es] a coupon keyed to said at least one of said articles containing said brand specific information." To better aid the Examiner in understanding the claimed invention, attention is directed toward page 11, line 15, through page 12, line 2, of the present specification. Therein a preferred embodiment magazine is described as including an article which discusses the benefits of physical exercise and which mentions national or store brand vitamins and includes appropriate discount coupons for some of the highlighted items.

In contrast to the coupons keyed to articles containing brand specific information, *Shedd* discloses the conventional technique of providing a recipe and including a coupon for a particular product comprising an ingredient of the recipe, column 3, lines 25-34. There is no hint or suggestion provided in the disclosure of *Shedd* that any coupon therein should be keyed to an article containing brand specific information as recited in the claims.

Accordingly, even assuming *arguendo* that one of ordinary skill in the art would have been led to modify a magazine of *Bullard* to include a coupon of *Shedd*, the claimed invention would not result. Specifically, there is no hint or suggestion provided by the disclosures of either *Bullard* or *Shedd* that a coupon be keyed or otherwise related to a general interest article containing brand specific information, nor has the Examiner asserted otherwise. Accordingly, it is respectfully asserted that claim 18, as amended, as well as the claims dependent therefrom are allowable under 35 U.S.C. § 103 over *Bullard* in view of *Shedd*.

Moreover, it is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. The language of the recited motivation is circular in nature, stating that it is obvious to make the modification (add promotional coupons) because it is obvious to achieve the result (provide a magazine with coupons to promote sales). Such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant

combination obvious unless the prior art also suggests the desirability of the combination, M.P.E.P. § 2143.01 citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Thus, the motivation for modifying *Bullard* in view of *Shedd* provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

Claim 20 recites that "each of said articles which contains specific brand information is authored under commission by a sponsor of the specific brand in said article." Similarly, claim 21 recites that "each of said articles which contains specific brand information is authored under commission of a specific store." Claim 23 further limits the invention of claim 20 by reciting that the content of each of the articles which contains specific brand information is controlled at least in part by a sponsor of the specific brand in the article.

In rejecting claims 18, 20, 21, and 23 over *Bullard* in view of *Lamphere* the Examiner asserts that "[i]t would have been obvious to one of ordinary skill in the art in view of the disclosure in col. 9, lines 5-12 of *Lamphere* et al to sell advertising space in *Bullard*, Jr. to store brands or national brands." Even if were assumed *arguendo* that the Examiner's assertion were true, the above claims would not be met. There simply is nothing in the disclosure of *Bullard* or *Lamphere* to teach or suggest that articles containing specific brand information be authored under commission of any particular entity, nor has the Examiner provided any statement to the contrary. Furthermore, there is nothing in the disclosure of *Bullard* or *Lamphere* to teach or suggest controlling the content of an article which contains specific brand information by any particular party, nor has the Examiner asserted otherwise. Accordingly, the 35 U.S.C. § 103 rejection of record with respect to claims 20, 21, and 23 is insufficient to establish a *prima facie* case of obviousness.

Claim 22 further limits the invention of claim 21 by reciting that the name of the specific store commissioning the articles which contain specific brand information appears on the front cover of the magazine. In rejecting this claim, the Examiner asserts that "it would have been obvious to one of ordinary skill in the art in view of the store name on the cover of the booklet in Fig. 4 of Lamphere et al to place the store name on the cover of the magazine of Bullard, Jr. so the shopper takes the right magazine to each store."

Initially it is noted that the Examiner's motivation is flawed in that *Bullard* does not provide a magazine which is expected to be taken to a store. Instead, *Bullard* teaches a magazine or book for advertising goods in which slots are provided to include samples of the

goods, see column 2, lines 27-46. There is no hint or suggestion provided in the disclosure of *Bullard* for a shopper to take a magazine thereof to any store, whether the name of a store appears thereon or not.

Moreover, even if one of ordinary skill in the art were to make the unsuggested modification to a magazine of *Bullard* to include the name of a store on the cover thereof, the claim would not be met. Specifically, claim 21 further modifies the limitations of claim 21 and, therefore, not only includes the name of a store upon the cover but includes the name of a store which commissioned articles having brand specific information included therein. This combination is not taught or suggested by *Bullard* in view of *Lamphere*, nor has the Examiner asserted otherwise.

IV. Summary

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

Dated: December 31, 2001

Respectfully submitted,

By _____

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Version With Markings to Show Changes Made

18. (Twice Amended) A magazine for use in promoting the purchase of specific products, said magazine comprising:

a plurality of general interest articles dispersed throughout the magazine;

at least one of said articles making reference to an identified product, said at least one of said articles including within its confines specific brand information pertaining to said identified product; and

a coupon keyed to said at least one of said articles containing said brand specific information.

Claim 24 has been canceled by this Amendment.

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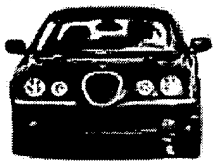

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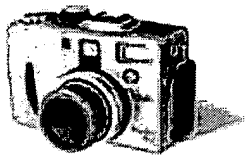

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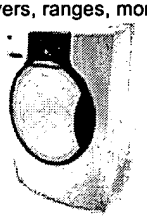

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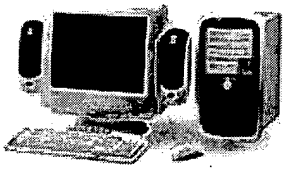

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